APR 0 8 2003 E

IN THE UNITED STATES PATENT AND TRADEMARK DEFICE

In re Application of:

Okel et al.

Serial No.: 09/636,308

Filed: August 11, 2000

For: PROJESS FOR PRODUCING CHEMICALLY TREATED FILLERS

.....

PATEUT ASILIBATILE

Group Art Unit: 1700

Examiner: 3. Blanco

PPG Case: 1507A0

APPEAL BRIEF

:

Hon. Commissioner of Patents and Trademarks Washington, D.C. 20231

Sir:

This application is before the Board of Fatent Appeals and Interferences from the Final Rejection dated November 15, 177, from the Examiner in charge of the above-captioned patent application. A Notice of Appeal to the Board of Patent Appeals and Interferences under 37 CFR 1.191 was filed with a Cartificate of Mailing dated February 20, 2003.

Third, willip that this orrespondence is being deposited with the Unit is distensible that is distensible that is distensible that is a standard mission places much in an entrelige accesses.

Associated months is not in a standard washing to, for 3 3 4

The state of the s

[,] Na. . A. Marr 1) je s og grende skare og perkur i tjenska 1 seur 15. mare

I. REAL PARTY IN INTEREST The real parties in interest are FES industries of , Inc. and Dow Corning Corporation by virtue of assignments lated April 17, 2001. II. RELATED AFPEAL AND INTEFFERENCES There are no related appeals or interferences kn which Appellants, Appellants' legal representative, or Appellants' assignee which will directly affect or be directly affected by in have a bearing on the Board's decision of this pending appeal. III. STATUS OF THE CLAIMS Claims Pending: Claims 1-18. Claims Cancelled: None. Claims Allowed: None. Claims Withdrawn from Consideration: None. Olaims 1-19. Claims Appealed: IV. STATUS OF AMENDMENTS No amendment was filed subsequent to the outstanding Final Rejection of November 22, 20,2. V. SUMMARY OF INVENTION Appellants' invention is directed to a process of producing a chemically treated filler by contacting an acidit aqueous suspension of an amorphous or particulate in ruanic (xiile) selected from precipitated Silica, colloidal silica in mintures. thereof with a doupling agent to form an action agreeds suspension of chemically treated filler, optionally in the presente of ϵ surfactant and/or a water miscible solvent, and recovering sail filler, the improvement comprises using as said coupling about a sembination of "a" mercaptborganemetallic dempound and "b" non-- _ -

sulfur organometallic compound s in a weight ratio if A $t \in S$ of at least 0.08:1 in an aquebus suspension of incommonorable. having a pH of 2.5 or less, and treating the adidic agreetus suspension of the chemically treated filler with a vilue itralizable: agent's to increase the pH of said suspension to a reduce of incre 3.1 to 10. VI. THE ISSUES The issues presented for review by this Appeal are: 1. Whether claims 1-3, 5-8, 10-12, 14-16, and 18 have been proporly rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner (U.S. Patent 4,436,847, in view of Burns et al. (U.S. Patent 6,051,672); 2. Whether claims 4 and 17 have been properly refected under 45 0.8.0. 13% as being unpatentable over Wagner U.S. Fatent 4,436,847) in view of Burns et al. U.S. Patent 6,051,672 as applied to claim 2 above, and further in view of druse at al. .WO 99/090361; and 3. Whether claims 9 and 13 have been properly rejected under 35 U.S.C. 103 a las being unpatentable over Wagner U.S. Patent 4,438,8400 in view or Burns et al. U.S. Patent 6,051,072 as applied to claims + uni 10 above, and turther in view at lightsev ét al. U.S. Patent 5,986,953 . - 3 -

UII. G#FUPING OF OLAIM The claims on appear stand in tail to perceat VIII. AFGUMENT A. Legal Authority A proper analysis under Section 113 requires, inter alia, consideration of two factors: In whether the prior and will a have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry but the claimed process; and (2) whether the prior are would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success. In re Vaeck, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). It is now well established by the Federal Gir but that bited prior art must provide one of ordinary skill in the art with the motivation to use the disclosure of a reference in a manual that renders the claims obvious; namely, there must be $s \circ m e$ teaching suggestion or incentive in the prior art disclosure that supports the rejection. This requirement stands as the pritical sateguard against nindsight analysis and rote application of the legal test for obviousness. See, in particular, In re Positet, 47 USPQ 2d 1453, 1458 (Fed. Cir. 1998). Further, see, In r. C.k Chemical Co., 837 F.2a 469, 473, 5 USPQ2d 1529, 1531 FA4. Cir. 1999 , wherein the Court found that "The consistent oritarion for determination of opviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process. should be carried out and would have a reasonable likelihooi : success, viewed in the light of the prior art ... Both the surpostion - - --

and the expectation of success must be founded in the price wit, not in the applicant's displasme." See also, In relational, will F.2d 781, 788, 4 USPQ2a 1971, 1978 Fed. Qir. 1987 Wherein the Court found that opviousness cannot be established "by ormbinous the teachings of the prior art to produce the claumed invent: i. absent some teaching or suggestion that the combination is necessarily Moregver, in Ex parts Clapp, 117 USP, 471, 973 Ed. Fat. Agg. v Int'f 1985; the Court found that "To support the conclusion that the claimed combination is directed to opvious subject marker, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the thaimed invention to have been obvious in light of the teachings of the references ... [S] implicity and hindsight are not proper principal tor resolving the issue of obviousness." In Emparte Haymond, 41 UCF. 2d 1217 (Bd. of Appeals 1996; the Court found that it is impermissible to use the claimed invention as an instruction manual or "template" in order to render the claimed invention obvious.

B. The Rejection of Claims 1-3, 5-4, 13-13, 14-18 and 15 under 35 U.S.C. 133 a

The Examiner has rejected claims 1-3, b-r, 11-10, 14-10 and 18 under 35 U.S.C. 103(a) as being unpatentable over Wagner U.S. Patent 4,436,847% in view of Burns et al. U.S. Farent 6,051,671. Appollance submit that these references taken without alone or in compunation do not fairly suggest the claimed invention.

Appellants submit that the Wagner NAAT patent access to disclose the pH at which the stland compliand composition is all it to the rupber compound, and further, this reference accessing eyes, suggest adjusting the pH of the reaction mixture. Moreover, a reason or purpose for adjusting the pH is not suggested. Thus, there would be no motivation for one of ordinary skill in the act at the time of the invention to modify the disclosure in the Wagner

"s4" patent by looking to the pH range displaced in the Burns et al. '872 patent. Based on the legal authority retired of we, the Wagner '84" patent does not displace the requisite "limit films suggestion or incentive." nor does the patent displace for "suggestion and the expectation of success" to support a displace the pH range disclosed in the Burns et al. 'e's patent with the method taught by the Wagner '84% patent. The mombination of these two references requires impermissible hindsight, thus rendering the rejection improper.

Furthermore, the Burns et al. '672 reference teaches conducting the reaction of colloidal silica with silicon compount at a pH of less than 4. However, the Burns et al. '672 reference does not disclose, nor even suggest, increasing the pH following completion of the aforementioned chemical reaction, as in the claimed invention. None of the Examples in the Burns et al. '872 patent recite any pH values. Thus, Appellants submit that it will not have been obvious to one of ordinary skill in the art at the time of the invention to modify the disclosure in the Wayner '942' patent by looking to the pH range disclosed in the Burns et al. '672 patent, to obtain the claimed invention.

Appellants submit that in view of the above remarks, the claimed invention would not have been obvious to one of trainary skill in the art at the time. Further, without impermissible hindsight reconstruction, there would be no motivation for one produce the claimed invention. Moreover, the claimed invention is not even remotely suggested by the Wagner and Burns references taken either alone or in commination.

3. The Rejection of Glaims 4 and 17 under 35 U.S.D. 113 a

The Examiner has rejected claims 4 and 17 unique 47 U.S.C. 103 $_{1}$ a, as being unpatentable over Wagner U.S. Fatent 4,436,847 in view of Burns et al. -U.S. Patent 6,751,871 as

applied to claim C above, and further in view in Cruse +6 al. W 99×09036. Appellants submit that these references taken wither alone or in combination do not fairly suggest the claimed invention.

Appellants submit that heither the Wadder 1-40 parent nor the Burns et al. Yell patent disploses blocked merchy will deco as coupling agents and further, the use of blocket mercept will degree is not even suggested in these two references. Moreovar, a reason or purpose for using blocked mercaptosilanes is not subdosted. Thus, there would be no motivation for one of ordinary skill in the art at the time of the invention to modify the disclosure in the Wagner '347 patent by looking to the Burns et al. 1672 patent, and the Cruse et al. '036 publication. Based on the legal authority resited above, neither the Wagner `847 patent nor the Burns et al. *672 patent discloses the requisite "...teaching suggestion or incentive..." nor does the patent disclose the "suggestion and the expectation of success" to support combining the blocked mercaptosilanes disclosed in the liuse et al. 1996 purily discussion with the methods taught by the Burns et al. NGT1 satent and the Washes 1647 patent. The combination of these references remaines impermissible hindsight, thus rendering the rejection improper.

Appellants submit that in view of the above remarks, to claimed invention would not have been obvious to one or ordinary skill in the art at the time. Further, without impermissiff himself the construction, there would be no motivation for one or ordinary skill to combine the teachings of Wagner, Burns and Truss to produce the claimed invention. Mareover, the glaimed invention is not even remotely suggested by the Wagner, Burns and Truss references taken either alone or in combination.

D. The Rejection of Claims R and 13 under 35 U.S.O. 103 at

The Examiner has rejected claims " and il under \pm " U.S.C. 103-a" as being unpatentable over Wagner U.S. Patent

_ - _

4,436,847) in view of Burns et al. U.S. Patent 6,181,470 as applied to claims 6 and 12 above, and further in view is hightony et al. U.S. Patent 6,985,968. Appellants submit that these references taken either alone or in symbination 1 hit is inly suggest the claimed invention.

Appellants submit that the use up previpitate bottles be not even suggested by the Wagner '84" patent has the Barns et al. NATE patent. Moreover, a reason or purpose for using pre-lightares. silica is not suggested by these two references. Thus, there were a be no motivation for one of ordinary skill in the art at the timeof the invention to modify the disclosure in the Wagner 1847 pater. by looking to the Burns et al. 1672 patent, and the Lightsey 1953 patent. Based on the legal authority redited above, neither the Wagner '847 patent nor the Burns et al. '672 patent discloses the requisite "...teaching suggestion or incentive..." nor does the patent disclose the "suggestion and the expectation of subject" to $\operatorname{sign}(z)$ compining the precipitated silica disclosed in the lightsey of all 1953 patent with the methods taught by the Burns of 41. NOTE parent and the Wagner 1847 patent. The combination of these feterences requires impermissible hindsight, thus rendering the retection improper.

Appellants submit that in view of the above remarks, the claimed invention would not have been obvious to one of crimary skill in the art at the time. Further, without impermissible ninusignt reconstruction, there would be no motivation for one of ordinary skill to compine the teachings of Wagner, Burns and Lightsey to produce the claimed invention. Moreover, the claimed invention is not even remotely suggested by the Wagner, Burns and Lightsey references taken either alone or in combination.

and control of Allowance of the appealed claims is selected to sewarranted based on the pontrolling rapts and appli also law. For the reasons stated, the Examiner errei in rejecting the class. The Examiner's Final Rejection should, therefore, he reversel dut the claims on appeal allowed. Respectfully submitted, Carol A. Marma Attorney of Record Registration No. 39,761 Telephone: (412 434-3797 Facsimile: 412: 434-4092 April 3, 2003 Pittsburgh, Pennsylvania _ 5 _